



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

JK

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/823,823 | 03/25/97 | TAUGHER | L 10970451-1 |

WM02/0717

022879
HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS CO 80527-2400

SU

| EXAMINER | |
|------------|--------------|
| NEYZARI, A | |
| ART UNIT | PAPER NUMBER |

2651
DATE MAILED: 07/17/01 *24*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

MAILED
JUL 17 2001
Technology Center 2600

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 28

Application Number: 08/823,823
Filing Date: 3/25/97
Appellant(s): Taugher

Taugher
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 6-8-2001.

Art Unit: 2651

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-11 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Art Unit: 2651

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Prior art disclosed in page 1-4 of the specification

Parker and Starrett, CD-ROM Professional's CD-Readable Handbook, 1996,
page 82

JP404095287

Takahashi et al

3-1992

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as
being indefinite for failing to particularly point out and distinctly claim
the subject matter which applicant regards as the invention.

Regarding claim 1, line 3, the phrase "capable of" renders the claim indefinite because
it is unclear whether the limitations following the phrase are part of the claimed invention.

Art Unit: 2651

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over prior art disclosed in the specification in view of Parker and Starrett and further in view of Japanese patent No 404095287 to Takahashi.

In page 1-4 of the specification applicant admits that write protection in rewritable disks are well known in the art. Applicant also admits that power calibration area are used in optical disks for calibrating laser power, since laser writing must be calibrated for each disk. This is a conventional method which also is disclosed by Kuroda et al as prior art (supporting document). Page 82 of "CD Recordable Handbook" by "Parker and Starrett", cited by applicant also discuss the Program Memory Area (PMA) and Power Calibration Area (PCA) on CD-R disks.

To cover any area of any subject in order to prevent an operation to take place in such an area is a common practice and is nothing new in the art. In fact Takahashi in Japanese patent No 404095287 discloses recording inhibition by detachable seal 8 (Fig 1).

Therefore it would be obvious when the power calibration area is covered by any means (such as a ring, since this is a circular area) the laser power calibration becomes impossible, which this can affect the operation of the system such as preventing the disk from rewriting.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to cover the calibration area of the prior art disk in order to affect the

Art Unit: 2651

operation of the system, operation such as rewriting in the disk, as taught by combination of above references.

(11) Response to Argument

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is found in the knowledge generally available to one of ordinary skill in the art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ali Neyzari
Primary Patent Examiner
Art Unit 2651 *Ali Neyzari*
July 11, 2001 ALI NEYZARI
PRIMARY EXAMINER

Conferees:

Tan Dinh *T. D.*
Primary Patent Examiner
Art Unit 2651

David Hudspeth
David Hudspeth
Supervisory Primary Examiner
Art Unit 2651